6/12/02

Paper No. 8
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Columbia Sportswear Company
v.
Marc T. Nguyen

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Opposition No. 117,291
to application Serial No. 75/680,165
filed on May 3, 1999

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Nancy J. Moriarty of Chernoff, Vilhauer, McClung & Stenzel, LLP for Columbia Sportswear Company.

Marc T. Nguyen, pro se.

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Before Cissel, Quinn and Chapman, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 3, 1999, applicant, a citizen of the United States, filed the above-referenced application to register the mark “TITANIUM JEANS” on the Principal Register for the following goods: “men’s, women’s and children’s clothing, namely jeans, sweat shirts, shirts, jackets, coats, sweat pants, slacks, suits, pants,

headbands, visors, caps, dresses, shoes, sneakers, boots, wristbands, socks, t-shirts, belts, undergarments, neckties, dress shirts, collared shirts, rugby shirts, hockey jerseys, football jerseys, basketball jerseys, baseball jerseys, knit shirts, shorts and sandals," in Class 25. As the basis for filing the application, applicant asserted that he possessed a bona fide intention to use the mark in commerce in connection with these goods. Following an Examiner's Amendment disclaiming the exclusive right to use the word "JEANS" apart from the mark as shown, the mark was published for opposition on December 28, 1999.

On March 7, 2000, a timely Notice of Opposition was filed by Columbia Sportswear Company, a corporation organized and existing under the laws of Oregon. As grounds for opposition, opposer alleged that long prior to the filing date of the opposed application, opposer adopted and has since used in commerce the mark "TITANIUM" for parkas, snowsuits, pants, jackets, sweaters, vests, and pullover windbreakers. Opposer pleaded that if applicant were to use the mark he seeks to register in connection with the clothing items specified in the application, applicant's mark so

resembles opposer's previously used mark that confusion would be likely.

Applicant's answer to the Notice of Opposition denied the essential allegations therein.

A trial was conducted in accordance with the Trademark Rules of Practice, but applicant neither took testimony nor submitted evidence. During its testimony period, opposer deposed Bob Masin, its director of sales and merchandising, but applicant declined to attend this deposition. Opposer filed a brief in support of its opposition, but applicant did not file a brief. Neither party requested an oral hearing before the Board.

Mr. Masin's testimony and the exhibits thereto establish that opposer first used the mark "TITANIUM" in 1993 in connection with outdoor clothing and footwear, and that opposer's use of the mark has been continuous since that time. The products on which the mark is used include outerwear such as parkas, jackets, gloves, pants and bibs, as well as sweaters, vests, socks, boots and shoes. "TITANIUM" is used by opposer on a premium line of these products. Sales of opposer's products bearing the mark have exceeded sixty million dollars since 1997. During that period, opposer has spent over five million dollars advertising these goods under the mark.

Opposer has thus established that it used the mark "TITANIUM" on products which include some of the same goods set forth in the application well before the filing date of applicant's intent-to-use application, so opposer clearly has priority.

The record similarly demonstrates that the marks are very similar, and that if applicant were to use the mark "TITANIUM JEANS" in connection with the same clothing products for men, women and children on which opposer has used its "TITANIUM" trademark (e.g., pants and jackets), confusion would be likely. Applicant has essentially appropriated opposer's entire mark, which the record shows is arbitrary in connection with these clothing items, and added a generic term to it, which certainly does not result in a mark which would be readily distinguished from opposer's mark if both were applied to the same and/or similar items of apparel. See: Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); and In re Rexel, Inc., 223 USPQ 830 (TTAB 1984).

We have no doubt as to the correctness of this conclusion, but even if we did, such doubt would necessarily be resolved in favor of the prior user, and against applicant, who, as the newcomer, has a duty to select a mark which is not likely to cause confusion with

one already in use in his field of commerce. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 643, 6 USPQ2d 1025 (Fed. Cir. 1988).

DECISION: The opposition is sustained and registration to applicant is refused.